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10/805,140	03/19/2004	Andrew Stollman	TRA143-826870	8919
21831 7590 05/09/2008 WOLF BLOCK SCHORR AND SOLIS-COHEN LLP 250 PARK AVENUE NEW YORK, NY 10177				
EXAMINER				
STIBLEY, MICHAEL R				
ART UNIT		PAPER NUMBER		
4194				
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Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

PTO@WOLFBLOCK.COM

Office Action Summary

Application No.

10/805,140

Applicant(s)

STOLLMAN ET AL.

Examiner

MICHAEL STIBLEY

Art Unit

4194

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 19 March 2004 and 15 February 2008.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-36 is/are pending in the application.
- 4a) Of the above claim(s) 30-33 and 35 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-29, 34, 36 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 19 March 2004 is/are: a) ☐ accepted or b) ☒ objected to by the Examiner.
- Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
- Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

1. This Office Action is in response to the application filed March 19, 2004.
2. Applicant's election without traverse of Group III, that is Claims 1-29, 34, and 36 in the reply filed on February 15, 2008 is acknowledged.
3. Claims 1-36 are pending in the application. Claims 30-33, and Claim 35 have been withdrawn from consideration. Claims 1-29, 34, and 36 have been examined. Applicant is requested to cancel unelected claims.

Drawings

4. The drawings are objected to as they are unreadable. New corrected drawings in compliance with 37 CFR 1.121(d) are required in this application because they are unreadable. Applicant is advised to employ the services of a competent patent draftsman outside the Office, as the U.S. Patent and Trademark Office no longer prepares new drawings. The corrected drawings are required in reply to the Office action to avoid abandonment of the application. The requirement for corrected drawings will not be held in abeyance.

Specification

5. Applicant is reminded of the proper language and format for an abstract of the disclosure.

The abstract should be in narrative form and generally limited to a single paragraph on a separate sheet within the range of 50 to 150 words. It is important that the abstract not exceed 150 words in length since the space provided for the abstract on the computer tape used by the printer is limited. The form and legal phraseology often used in patent claims, such as "means" and "said," should be avoided. The abstract should describe the disclosure sufficiently to assist readers in deciding whether there is a need for consulting the full patent text for details.

The language should be clear and concise and should not repeat information given in the title. It should avoid using phrases which can be implied, such as, "The disclosure concerns," "The disclosure defined by this invention," "The disclosure describes," etc.

6. The abstract of the disclosure is objected to because the abstract is currently greater than 150 words in length. Correction is required. See MPEP § 608.01(b).

Claim Rejections - 35 USC § 112

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

8. Claims 17-22 and 36 is rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.
9. As per Claims 17-22 and 36, the language "and/or" is unclear as it is uncertain as to whether goods are only required, or whether services are only required, or both goods and services are required. To traverse this rejection, Applicant should clarify by using "and" or "or" but not "and/or". Examiner shall apply alternative language.
10. As per Claim 36, the language "and/or" is unclear as it is uncertain as to whether registration information is only required, or whether financial account information is only required, or both registration information and financial account information are required. To traverse this rejection, Applicant should clarify by using "and" or "or" but not "and/or". Examiner shall apply alternative language.
11. As per Claim 36, "more or less" is additionally confusing in that it does not particularly point out and distinctly claim the invention. If the soliciting financial account information from the user is concurrently performed with the displaying of the

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sweepstakes offers, then applicant should use the word concurrently, with no "more or less" before it. If the soliciting financial account information from the user is not concurrently performed with the displaying of the sweepstakes offers, then the word concurrently should not be used. Examiner will assume that applicant intended for the solicitation to occur very soon after the display of the sweepstakes offer, and not concurrently.

12. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

13. Claim 24 is rejected under 35 U.S.C. 112, first paragraph, because the specification, while being enabling for stated purpose, does not reasonably provide enablement for the apparatus. The specification does not enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the invention commensurate in scope with these claims. Claim 24 is a single means claim as discussed in MPEP 2164.08(a).

Claim Rejections - 35 USC § 101

14. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

Claims 28-29 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter as they are carrier wave signals.

Claim Rejections - 35 USC § 103

15. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

16. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

17. **Claims 1-29, 34, and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Kelly et al (KELLY) (US 6,645,068 B1) in view of Yacenda (YACENDA) (US 6,322,446 B1).**

18. **As per Claims 1-29, 34 and 36** *A method for dynamically generating and serving graphics based advertising offers to a user over an interactive communications network based upon information previously collected from the user through a virtual portal, which comprises the steps of: "...network..." see at least abstract, 7:15-27; 19:15-25 "...internet..." Fig 5, 1:20-35; 4:14-27; 7:15:30; 8:50-65 "...computer ..." abstract, 1:20-30; 2:33-47; 3:1-16; 4:44-57; 6:5-26; 5:18-55; 7:1-6; 13:58-67; 16:54-64 "...computer readable medium..." 5:30-55 "...hard disk drive..." 5:30-55 "...software (instructions)(programming)..." 5:30-55; 6:49-56; 7:28-46; 14:1-15; 13:30-57*

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"...functions..." 4:28-42; 5:8-17; 5:55-65; 13:10-25 "...function..." 4:14-26; 8:35-48; 8:50-65; 9:45-50; 18:40-51

19. i. **displaying** a registration page to the user a user upon the user's entry to a virtual portal of a lottery Web site; "...registration..." Figs 4, 7, 8, 12, Col(s):Line(s) 3:50-56; 10:10-55; 11:25-30; 11:55-65; 13:10-25; 18:15-35; 19:30-50; "...portal..." Fig 4
"...web (site)(browser)(page)(server)..." abstract, Figs. 4, 1:20-35; 2:33-47; 6:14-27; 6:40-67; 7:38-45; 10:40-55; 12:35-46; 15:3-20; 18:10-51; "...the games may include a "game of chance" (lottery) where the outcome of the game is determined primarily on chance..." 12:30-35 "...display..." 5:65-6:6; 10:40-55; 18:40-62; 19:9-16; 19:25-31; 19:53-67 "...profile (driven)..." abstract, Fig 14, 2:20-47; 10:30-60; 12:45-56; 15:3-20; 19:30-52 "...geographic (geographic information)..." 3:1-16; 7:50-65; 12:20-35; 13:10-25 "...age (biographic information)..." 2:4-15; 1:35-50; 3:1-16; 12:20-35; 13:10-25 "... (user) name and an e-mail address (biographic information)..." 10:40-55 "...screen..." 6:1-6; 5:18-28

20. ii. **receiving** selected registration information solicited from the user; "...log-on..." Fig 14, 7:1-5; 19:40-45; "...logs on..." 6:14-27; 19:25-31 "...receive..." Figs 4A, "...registration..." Figs 4, 7, 8, 12, Col(s):Line(s) 3:50-56; 10:10-55; 11:25-30; 11:55-65; 13:10-25; 18:15-35; 19:30-50; "...profile (driven)..." abstract, Fig 14, 2:20-47; 10:30-60; 12:45-56; 15:3-20; 19:30-52

21. iii. **validating and storing** the registration information in a selected database; "...validates..." 11:35-47; "...storing..." Fig 14, "...stores..." Fig 5, 19:25-31; "...stored..." 5:29-55; 8:1-20; 11:30-37; 17:1-5; "...store..." Fig 8, 16: 54-64

"...storage..." Fig 5, 4:44-57; 6:5-15; 8:9-35; 7:28-37 "...verify..." Fig. 12, 6:28-40; 11:37-47 "...server..." Figs 4, 5, 11, 4:14-43; 3:45-46; 6:15-67; 7:5-60; 8:5-60; 9:1-33; 10:30-40; 12:1-67; 11:35-50; 13:1-67; 14:20-25; 14:60-65; 16:1-67; 15:45-50; 17:1-5; 18:10-45; 19:1-5 "...servers..." 3:45-50; 4:60-65; 6:15-20; 6:55-60; 7:40-50; 12:55-67; 13:1-10; "...host server..." Fig 11, 16:15-20; 16:55-67; 17:1-5 "...RAM...ROM..." Fig. 2; 5:30-65; "...registration..." Figs 4, 7, 8, 12, Col(s):Line(s) 3:50-56; 10:10-55; 11:25-30; 11:55-65; 13:10-25; 18:15-35; 19:30-50; "... (prize) database..." Fig 4, 4:14-43; 6:27-40; 7:5-27; 9:9-26; 10:30-40; 12:1-10; 11:35-57; 12:35-67; 13:1-67; 14:59-67; 16:1-5; 15:39-53; 18:1-17; 18:34-51; 19:1-10 "...profile (driven)..." abstract, Fig 14, 2:20-47; 10:30-60; 12:45-56; 15:3-20; 19:30-52 "...secure sockets layer (SSL)..." 8:35-50

22. iv. **displaying** a virtual popup Web page to the user with one or more selected Sweepstakes offers and, more or less concurrently, soliciting financial account information from the user; "...display..." Figs 4, 11, 12, 6:1-6; 10:40-55; 18:34-19:67 "...displayed..." 5:18-29; 7:1-6; 13:39-57; 14:59-15:20; 16:12-33; 19:15-67; "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41 "...accounts..." 10:60-11:47 "...dynamic HTML..." 19:10-20 "...graphical user interface..." Fig. 13, 4:5-10; 18:50-62 "...web (site)(browser)(page)(server)..." abstract, Figs. 4, 1:20-35; 2:33-47; 6:14-27; 6:40-67; 7:38-45; 10:40-55; 12:35-46; 15:3-20; 18:10-51; "...games (sweepstakes)..." Figs 4,5,6,9,11A; 2:20-35; 1:35-67; 3:1-16; 4:15-50; 3:58-62; 6:15-27; 6:40-50; 7:5-37; 8:20-35; 8:50-67; 9:9-50; 10:23-30; 11:1-37; 11:57-67; 12:1-40; 14:1-35; 13:10-25; 13:39-57; 16:34-47; 15:30-53; 17:1-35; 17:54-67 "... (games of) chance..." 1:35-50; 12:20-35; 13:10-25

23. v. **receiving** Sweepstakes and financial account information input by the user;

"...input/output...I/O..." Fig. 2; 6:1-15; 5:8-67; "...receiving an indication of an outcome of at least one game..." Fig 11A "...credit card..." 7:38-46; "...valid credit card number..." 11:5-17; "...outcome..." Figs 4A, 11A, 4:30-35; 4:45-55; 7:20-30; 12:20-35; 17:20-67; "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41 "...accounts..." 10:60-11:47

24. vi. **validating and storing** the financial account information in the selected database; "...storing..." Fig 14, "...stores..." Fig 5, 19:25-31; "...database..." Fig 4, "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41
"...accounts..." 10:60-11:47; "...valid credit card number..." 11:5-17;

25. vii. **comparing** the financial account information to a pre-determined Sweepstakes winning number to determine whether the user is a winner; "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41 "...accounts..." 10:60-11:47
"...credit card..." 7:38-46; "...valid credit card number..." 11:5-17 "...winning..." Fig 11A, 5:10-17; 6:55-67; 12:1-10; 14:49-58; 17:35-53 "...win..." Fig 4, 11:18-25; 14:40-50; 13:39-57 "...winner..." 17:35-45 "...won..." 4:14-26; 9:25-45; 10:30-40; 15:54-65
"...credits..." Figs 4A, 6, 8, 9, 10, 11A, 2:25-30; 2:50-60; 4:30-40; 3:55-60; 4:65-67; 6:20-35; 6:60-65; 7:20-27; 7:50-67; 9:1-17; 10:1-10; 10:35-40; 9:40-45; 11:1-67; 12:1-67; 13:5-10; 13:65-67; 14:1-67; 15:1-67; 17:1-67; 18:1-67 "...If game credits were won, such game credits are added to the account of the player. If prize credits were won such prize credits are added to the account of the player. If

merchandise has been won, such merchandise is added to the player's shopping cart..." 9:30-40; "...the user is notified of any prize credits ..." 6:25-40

26. viii. *if the financial account information matches the winning data set, displaying a Web page popup to the user with notification that funds have been deposited in a financial account of the user, "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41 "...accounts..." 10:60-11:47 "...credits..." Figs 4A, 6, 8, 9, 10, 11A, 2:25-30; 2:50-60; 4:30-40; 3:55-60; 4:65-67; 6:20-35; 6:60-65; 7:20-27; 7:50-67; 9:1-17; 10:1-10; 10:35-40; 9:40-45; 11:1-67; 12:1-67; 13:5-10; 13:65-67; 14:1-67; 15:1-67; 17:1-67; 18:1-67 "...If game credits were won, such game credits are added to the account of the player. If prize credits were won such prize credits are added to the account of the player. If merchandise has been won, such merchandise is added to the player's shopping cart..." 9:30-40; "...the user is notified of any prize credits ..." 6:25-40 "...credit card..." 7:38-46; "...valid credit card number..." 11:5-17 "...winning..." Fig 11A, 5:10-17; 6:55-67; 12:1-10; 14:49-58; 17:35-53 "...win..." Fig 4, 11:18-25; 14:40-50; 13:39-57 "...winner..." 17:35-45 "...won..." 4:14-26; 9:25-45; 10:30-40; 15:54-65*

27. ix. *if the financial account information does not match the winning data match, generating a new winning number according to governing Sweepstakes rules; (little patentable weight is given to governing Sweepstakes rules as rules governing a game are per se not patentable, additionally, if the financial account information matches the winning data set, then this limitation is not applicable) "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41 "...accounts..." 10:60-11:47 "...credit*

card..." 7:38-46; "...valid credit card number..." 11:5-17 "...winning..." Fig 11A, 5:10-17; 6:55-67; 12:1-10; 14:49-58; 17:35-53 "...win..." Fig 4, 11:18-25; 14:40-50; 13:39-57 "...winner..." 17:35-45 "...won..." 4:14-26; 9:25-45; 10:30-40; 15:54-65

28. x. **pre-selecting** marketing offers based on user's registration information and/or financial account information; "...target advertising..." 1:52-60; "...targeting advertising towards users fitting into various market profiles..." 3:15-25
"...selecting and presenting advertising..." 1:50-57; "...allow particular advertising presented to a user during play of the game to be directed to particular users based on the selected identifier..." 3:15-20 "...advertisements ..." Fig 9, 9:45-60; 11:15-25; 13:39-57; 15:39-54; 18:40-51; 19:15-25; 19:53-67 "...advertisement..." Fig 14, 4:8-10; 9:50-60; 13:30-57; 15:39-53; 19:9-67

29. xi. **displaying** the pre-selected marketing offers to the user; "...advertising cartridge..." Figs. 4, 5, 6:60-67; "...displaying advertisements..." 13:39-57
"...displaying an advertisement of an advertiser during use of the system by the user..." Fig 14. "...this system enables a provider of the network gaming system to focus advertising towards particular users of the network system and also report the interest shown by particular users towards particular advertisers and advertisements..." 19:20-25 "...advertisements..." Fig 9, 9:45-60; 11:15-25; 13:39-57; 15:39-54; 18:40-51; 19:15-25; 19:53-67 "...advertisement..." Fig 14, 4:8-10; 9:50-60; 13:30-57; 15:39-53; 19:9-67 "...java script banner ad launches (popup and dynamically served) new window with java game..." Fig 4; "...optionally, the prize redemption interface page may display advertisements, notification of specials

(dynamically served/popup)..."18:40-51 "...upon winning a number of prize credits, the user is then forwarded to a prize redemption interface governed by the prize redemption cartridge (dynamically served/popup)..."6:55-67

30. xii. **receiving** user-selected data corresponding to the offers; "...in response to an action by the user..." 19:15-67 "...advertisement feedback system..." Fig 14, 4:8-12; 19:15-67 "...selected..." 2:33-65; 3:1-30; 6:28-40; 19:9-47 "... (reporting) interest (psychographic information)..." Fig 14, 19:15-25; 19:53-67

31. xiii. **validating** and storing the user-selected data in the selected database; "...an account of the user is then checked to verify a current number of prize credits available..." 6:30-35; "...in response to an action by the user..." 19:15-67 "...advertisement feedback system..." Fig 14, 4:8-12; 19:15-67 "...selected..." 2:33-65; 3:1-30; 6:28-40; 19:9-47 "... (reporting) interest..." Fig 14, 19:15-25; 19:53-67

32. xiv. **processing** the financial transaction associated with the user-selected data using the user's stored financial account information; "...account..." Fig. 8, 6:14-40; 9:1-50; 10:60-11:47; 13:10-25; 18:18-41 "...accounts..." 10:60-11:47 "... (secure) credit card..." 7:38-46; "...valid credit card number..."11:5-17

33. xv. **filling** orders for goods and/or services placed by the user through the user-selected data; "...the game database orders any prizes selected by the user from a prize vendor..." 6:35-36 "...selected..." 2:33-65; 3:1-30; 6:28-40; 19:9-47

34. xvi. upon completion of financial transaction processing, delivering the goods and/or services to the user; "...the prize is then delivered to the user in operation 314..." 6:35-40 "...deliver (delivered)..." Fig 12, 18:18-41; 6:35-40; 7:1-6 and

35. xvii. **displaying** one or more additional targeted marketing offers to the user based upon financial account information and registration information input by the user.

"...displaying advertisements..." 13:39-57 "...displaying an advertisement of an advertiser during use of the system by the user..." Fig 14.

36. **KELLY** generally teaches as outlined above:

37. games of chance, as a lottery is a game of chance, but does not specifically teach a data matching ie a winning number selected such as in a lottery or sweepstakes;

38. **HOWEVER, YACENDA** does teach selecting a winning number ie, data match within a lottery or sweepstakes game; "...**lottery...winning numbers...**" abstract, 6:1-67; 5:1-67; 7:1-67

39. **THEREFORE**, it would have been obvious at the time of the invention to a person having ordinary skill in the art to combine the teachings of KELLY with YACENDA, **thereby** providing for a profile-driven network gaming and prize redemption system incorporating lotteries as a lottery is a game of chance.

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to MICHAEL STIBLEY whose telephone number is (571)270-3612. The examiner can normally be reached on Monday through Friday 7:30am to 5:00pm EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Charles Kyle can be reached on (571) 272-6746. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/Michael Stibley/
Examiner, Art Unit 4194
Wednesday, May 07, 2008

/Charles R. Kyle/
Supervisory Patent Examiner, Art Unit 4194